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EXAMINER

VYAS, ABHISHEK

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3691

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/619,022	Applicant(s) KATZ ET AL.	
	Examiner ABHISHEK VYAS	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment and remarks filed on 03/17/2009
2. Claims 1 and 12 have been amended.
3. Claims 1-23 are currently pending and have been examined.
4. Claims 1-23 are rejected.
5. This is a FINAL rejection.

Response to Arguments

6. Applicant's arguments filed 03/17/2009 have been fully considered but they are not persuasive.
7. Applicant's arguments regarding the 35 USC 101 rejections have been fully considered but they are not persuasive. According to *In re Bilski*, the recited machine or transformation must not consist merely of "insignificant extra-solution activity." The "transformation must be central to the purpose of the claimed process." The mere recitation of "A computer implemented method having a computing system" in the preamble of the claim does not fully qualify the claim as statutory. Some of the steps in the claims can or could be carried out manually. Further, the preamble is not given patentable weight.
8. The system claims must recite sufficient structure or hardware, the mere recitation of a computing system containing encoded data (which may or may not be the modules recited in the limitations of claims 1) without any recitation of hardware structure that can execute the data is not sufficient to persuasively overcome the 35 USC 101 rejections. The rejection is therefore maintained.
9. In response to applicant's argument to the 35 USC 103 rejections that Lawrence (7,181,428) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed

Art Unit: 3691

invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, although Lawrence '428 may address the question of how to discover political risk from a host of potential events and activities, it still discloses various functional limitations similar in identifying monetary risk as claimed in the instant application. Lawrence discloses identifying, monitoring and evaluating financial transactions for suspicious activities and risks (see Lawrence '428 column 4 lines 28-63, figure 3 and related text). Therefore the argument that Lawrence '428 is allegedly non-analogous to the instant application is unpersuasive.

10. In response to applicant's argument that Lawrence fails to teach or suggest all of the limitations of claims 1 and 12; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. In particular, claim 1 recites in the preamble "A computing system containing encoded data that when executed provides an anti-money laundering system for providing risk assessment determinations" the body of the claim does not contain any limitations indicating the structure of

Art Unit: 3691

the device. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Applicant's claimed limitations consist of modules (software according to the specification) that do not describe the structure of the device. Appropriate correction is required. Are the modules the encoded data? It is vague and indefinite how the encoded data is linked to the modules and what structural component (hardware) of a computing system is executing the data.

14. Claim 12, recites "A computer implemented method having a computing system containing encoded data that when executed provides anti-money laundering risk assessment determinations at a branch" it unclear how the computer implemented method *having a computing system* carries out the transformation central to the operation of the claim. It is vague and indefinite how such steps are being performed without being tied to a machine.
15. Claims 2-11, and 13-23 are rejected on their dependencies to claim 1 and 12.

Claim Rejections - 35 USC § 101

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. Claim 1-11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
18. Claim 1 recites in the preamble "A computing system containing encoded data that when executed provides an anti-money laundering system for providing risk assessment determinations" The body of claim 1 recites "code means" for each limitation. Therefore claim 1 is non-statutory because it is directed towards software, per se, lacking storage on a medium, which enables any underlying functionality to occur. It is not clear whether instructions are in executable form and therefore there is no practical application.
19. Claims 2-11 are rejected for their dependency on claim 1.

Art Unit: 3691

20. Claims 12-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
21. Claims 12-23 recite a process comprising the steps of identifying, assigning, identifying, determining, performing and providing. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the machine to which it is tied, for example by identifying the apparatus (or machine) that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Claim 1 and 12 at issue do not recite a machine and instead claim use of mental processes (as interpreted in light of 35 USC 112 second paragraph) to solve the step of identifying, assigning, identifying, determining, performing and providing and thereby seeking to patent use of human intelligence in and of itself.
22. Claims 13-23 are rejected for their dependency to claim 12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. **Claims 1-23** rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence United States Patent No. 7,181,428 in view of Lawrence United States Patent Application Publication No.: 2003/0177087 (herein after Lawrence '087)

24. **As per claim 1**, Lawrence discloses the following limitations:

- a risk assessor module for providing to an authorized user of the anti-money-laundering system, guidelines in identifying risk dimensions associated with potential money laundering transactions processed by the branch of the financial institution (see at least Lawrence column 1, lines 14-27; column 2, lines 58-67; column 3, lines 13-22 and 65-67; column 4, lines 47-50; column 5, lines 16-30).
- a policy builder module for recommending possible electronic and manual countermeasures to the risks identified by the risk assessor module and for enabling the authorized user to select the countermeasures of his choice in order to create a policy for the branch of the financial institution (see at least Lawrence column 2, lines 40-42; column 3, lines 3-12).
- an account opening due diligence module for providing detailed recommendations to the authorized user as to whether to allow an application for an account at the branch of the financial institution and for applying consistent implementation of the policy throughout the branch of the financial institution; (see at least Lawrence column 2, lines 38-40; and lines 53-62).

Lawrence does not specifically disclose the following limitation. Lawrence '087, however, teaches the limitations as follows:

- a transaction activity monitor module for receiving and monitoring transaction information including transaction information received by the account opening due diligence module, identifying risk dimensions associated with potential money laundering transactions processed by the branch of the financial institution, assigning numerical designations for the risk dimensions identified for the branch of a financial institution and for identifying suspicious patterns among the transactions at the

Art Unit: 3691

branch of the financial institution in order to provide a suspicious transaction activity report; related to potential money laundering transaction processed by (see at least Lawrence '087 paragraphs 0008-0010, 0022-0024, 0028, 0040-0042, 0047, 0065, 0068-71).

- a case management and reporting module for tracking and identifying the detailed recommendations of the account opening due diligence module in order to provide continuous feedback to the authorized user about the effectiveness of the 25 system (see at least Lawrence'087 paragraphs 0028-0029, 0046, 0068-0069).
- identifying suspicious patterns among the transactions includes determining whether a financial transaction to be conducted has a risk related dimension (see at least Lawrence '087 paragraphs 0008-0010, 0028, 0038, 0055-56, 0066-69, 0078).
- determining whether the numerical designation of at least a selected one of the identified risk dimensions for the financial transaction to be conducted exceeds a predetermined level when the financial transaction to be conducted does have a risk-related dimension; and (see at least Lawrence '087 paragraphs 0008-0010, 0055-56, 0065-0069, 0071, 0078).
- performing a special risk assessment procedure if the numerical designation of at least a selected one of the identified risk dimensions exceeds a predetermined level (see at least Lawrence '087 paragraphs 0008-0009, 0055-56, 0065-67, 0097 and figure 7C).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Lawrence with Lawrence '087 to monitor transactions and high risk transactions to prevent money laundering and associated liabilities (see at least Lawrence '428 column 3, lines 18-22; column 4, lines 44-55; column 5, lines 22-30; column 6, lines 35-40; column 8, lines 44-48; Lawrence '087 paragraphs 0006, 0008-009).

25. **As per claim 2**, Lawrence teaches the following limitation:

Art Unit: 3691

- a staff training and policy management module for using the selected countermeasures to develop customized training programs and to track compliance of users of the anti-money-laundering system (see at least Lawrence column 3, lines 65-67; column 4, lines 47-55).

26. **As per claim 3**, Lawrence teaches the following limitation:

- the risk assessor module comprise geographic location risk, types of customers served, and types of services offered by the financial institution (see at least Lawrence column 1, lines 56-60; column 4, lines 56-67; column 5, lines 34-36 and column 8, lines 16-24).

27. **As per claim 4**, Lawrence discloses the limitation as follows:

- the policy builder module provides detailed support for the decision process in creating the policy (see at least Lawrence column 6, lines 33-40; column 7, lines 1-9).

28. **As per claim 5**, Lawrence discloses following limitation:

- the authorized user can override for the branch of the financial institution, the detailed recommendations provided by the account opening due diligence module (see at least Lawrence column 5, lines 42-50).

29. **As per claim 6**, Lawrence teaches the following limitation:

- the transaction information received and monitored by the transaction activity monitor further comprise historical data (see at least Lawrence column 5, lines 66-67; column 6, line 1).

30. **As per claim 7**, Lawrence teaches the following limitation:

- the transaction information received and monitored by the transaction activity monitor further comprises input from employees of the branch of the financial institution (see at least Lawrence column 3, line 65; column 4, lines 5-18).

31. **As per claim 8**, Lawrence teaches the following limitation:

- the case management and reporting module tracks and identifies the detailed recommendations of the account opening due diligence module that are overridden

by the authorized user, and updates the account opening due diligence module based on the override (see at least Lawrence column 3, lines 3-5, lines 18-22; column 5, line 42-50).

32. **As per claim 9**, Lawrence teaches the following limitation:

- the risks identified by the risk assessor module are used to determine the level of review applied against a selected operation or transaction (see at least Lawrence column 3, lines 23-27; column 4, line 19-31, lines 47-50).

33. **As per claim 10**, Lawrence teaches the following limitation:

- the level of review is selected from the group consisting of standard review or special review (see at least Lawrence column 8, lines 39-41).

34. **As per claim 11**, Lawrence teaches the following limitation:

- the system is communicatively coupled to an electronic network including a plurality of databases, and wherein the transaction activity monitor component gathers information stored on the plurality of databases in order to monitor the suspicious transactions, and processes the information to output the risk assessment guidelines and an explanation of the risk assessment guidelines (see at least Lawrence column 8, lines 7-15).

35. **As per claim 12**, Lawrence discloses the following limitation:

- identifying risk dimensions associated with potential money laundering transactions processed by the branch of a financial institution (see at least Lawrence column 1, lines 14-25).
- assigning numerical designations for the risk dimensions identified for the branch of a financial institution (see at least Lawrence column 5, lines 15-21; column 6, lines 33-40).
- providing to an authorized user recommended guidelines for handling the financial transaction to be conducted, based on the special risk assessment procedure (see at least Lawrence column 9, lines 15-32).

Art Unit: 3691

- determining whether the numerical designation of at least a selected one of the identified risk dimensions for the financial transaction to be conducted exceeds a predetermined level, if the financial transaction to be conducted does have a risk-related dimension (see at least Lawrence column 5, lines 22-30; column 8, lines 44-48).

Lawrence does not specifically disclose the following limitations Lawrence '087, however teaches, the following limitations:

- identifying a type of financial transaction to be conducted at the branch of a financial institution (see at least Lawrence '087 paragraphs 008-0010, 0022-0024).
- determining whether a financial transaction to be conducted has a risk-related dimension (see at least Lawrence '087 paragraphs 0040-0042, 0047, 0065).
- performing a special risk assessment procedure when the numerical designation of at least a selected one of the identified risk dimensions exceeds a predetermined level (see at least Lawrence '087 paragraphs 0040-0042, 0047, 0065)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Lawrence with Lawrence '087 to monitor transactions and high risk transactions to prevent money laundering and associated liabilities (see at least Lawrence column 5, lines 22-30; column 6, lines 35-40; column 8, lines 44-48; Lawrence '087 paragraphs 0006, 0008).

36. **As per claim 13**, Lawrence teaches the following limitation:

- performing a standard risk assessment procedure if the numerical designation of none of the identified risk dimensions exceeds a predetermined level (see at least Lawrence column 9, lines 20-23).

37. **As per claim 14**, Lawrence teaches the following limitation:

- a first risk dimension representing a risk due to a location of the branch of the financial institution (see at least Lawrence column 8, lines: 18-24; 44-45; 59-61).

Art Unit: 3691

- a second risk dimension representing the risks due to selected services offered by the branch of a financial institution (see at least Lawrence column 8, lines 44-45; lines 64-67; column 9, lines 1-14).
- a third risk dimension representing the risks due to an identified nature of the customers served by the branch of the financial institution (see at least Lawrence column 8, lines 44-45, 53-58).
- a fourth risk dimension representing the risks due to a particular jurisdiction served by branch of a financial institution (see at least Lawrence column 5, lines 53-56; column 7, lines 54-67).

38. **As per claim 15**, Lawrence teaches the following limitation:

- the risk dimensions are based on local laws, regulations, historical data, and other information that is specific to the branch of the financial institution (see at least Lawrence column 4, lines 32-36).

39. **As per claim 16**, Lawrence discloses the following limitation:

- each of the selected services has associated accounts, each of the associated accounts having a risk rating and risk exposure rating, and wherein each risk dimension is based on a risk rating and a risk exposure rating of all associated accounts of all of the selected services (see at least Lawrence column 2, lines 34-42; column 5, lines 38-42; column 6, lines 35-40).

40. **As per claim 17**, Lawrence teaches the following limitation:

- the second and the third risk dimensions are based on data collected from the selected services (see at least Lawrence column 4, lines 5-18; column 7, lines 54-67; column 8, lines 1-15).

41. **As per claim 18**, Lawrence discloses the following limitation:

- performing a standard risk assessment procedure if it is determined that the financial transaction to be conducted does not have a risk-related dimension, wherein the

standard risk assessment is based on the average of the numerical designation for all of the risks (see at least Lawrence column 6, lines 35-38; column 9, lines 59-62).

42. **As per claim 19**, Lawrence teaches the following limitation:

- the type of financial transaction to be conducted at the branch of a financial institution comprises opening an account, and wherein the risk dimension for the account opening is based on the risk due to the identified nature of the customers served by the branch of the financial institution (see at least Lawrence column 5, lines 36-42).

43. **As per claim 20**, Lawrence teaches the following limitation:

- wherein the nature of the customers served by the branch of the financial institution includes high-risk clientele, and wherein the special risk assessment procedure is performed for the account opening (see at least Lawrence column 1, lines 11-13, lines 30-43; column 2, lines 53-55).

44. **As per claim 21**, Lawrence teaches the following limitation:

- when it is determined to perform a special risk assessment procedure for a financial transaction, the special risk assessment procedure is performed semi-annually, and wherein when it is determined to perform a standard risk assessment procedure for a financial transaction, the standard risk assessment procedure is performed annually (see at least Lawrence column 3, lines 65-67; column 6, lines 14-18).

45. **As per claim 22**, Lawrence teaches the following limitation:

- overriding by an authorized user the recommended guidelines for handling the financial transaction to be conducted (see at least Lawrence column 5, lines 42-50).

46. **As per claim 23**, Lawrence teaches the following limitation:

- the authorized user provides alternative guidelines after the step of overriding the recommended guidelines for handling the financial transaction to be conducted (see at least Lawrence column 5, lines 51-56; column 6, lines 20-23).

Conclusion

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abhishek Vyas whose telephone number is 571-270-1836. The examiner can normally be reached on 7:30am-5:00pm EST Mon-Thur, ALT Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. V. /
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691